

### **REMARKS**

Claims 1-2 are pending in the present application. Claim 3 was previously withdrawn in response to a restriction requirement.

In the present Office Action, the Examiner has rejected claims 1 and 2 under the doctrine of non-statutory double patenting.

In the present Office Action, the Examiner rejected claims 1 and 2 as being anticipated by Rao U.S. Pat. No. 5,477,820.

The Examiner classified the Office Action as Final.

Applicant hereby responds to the Examiner's objections and rejections as described below.

#### **A. Double Patenting Rejection**

In the present Office Action, the Examiner raises *for the first time* a double patenting rejection of claims 1 and 2. The Examiner rejected all of the presently pending claims under the doctrine of non-statutory double patenting as being unpatentable over claims 1-66 of U.S. Pat. No. 6,655,369. Without conceding to the Examiner's characterization, Applicant herein submits the requested disclaimer over the '211 patent, attached hereto as Exhibit A.

#### **B. Rejection of Claim 1 as Anticipated by Rao under 35 U.S.C. §102(b)**

In the present Office Action, the Examiner rejected claim 1 under 35 U.S.C. §102(b) as being unpatentable over Rao, U.S. Pat. No. 5,477,820. Rao is directed towards an insulating barrier applied to the face of a piston, in order to retard thermal conduction through the piston face. The thermal barrier ("heat management coatings" or "thermal diffusivity

coatings” in the lexicon of Rao) is recited as having about 8% nickel, which does not meet the limitation that the coating of the present invention “compris[es] between greater than 15% and about 80% nickel.” Accordingly, Rao cannot anticipate claim 1 of the present invention, as previously submitted. Furthermore, as Rao teaches thermal coatings, rather than catalytic effects, there is no suggestion that Rao can be combined with any other reference with respect to assertions of obviousness.

Accordingly, Applicant believes that Rao neither anticipates claim 1 as previously presented as amended, nor is claim 1 as previously presented obvious in view of Rao, and accordingly, claim 1 as previously presented is believed to be in allowable condition.

**C. Rejection of Claim 2 as Anticipated by Rao under 35 U.S.C. §102(b)**

In the present Office Action, the Examiner rejected claim 2 under 35 U.S.C. §102(b) as being unpatentable over Rao, U.S. Pat. No. 5,477,820. This patent is discussed above with respect to claim 1.

Claim 2 of the present patent application has been amended to further distinguish the Rao reference. As noted, Rao is directed towards an insulating barrier applied to the face of a piston, in order to retard thermal conduction through the patent face. The thermal barrier (“heat management coatings” or “thermal diffusivity coatings” in the lexicon of Rao) is recited as having about 20% chromium, and claimed as having 22% by weight of chromium. As amended, the lower limit of chromium in the coating of the present invention has been increased “to about 25%” from “about 10%,” and accordingly claim 2 as amended is not anticipated by Rao.

Furthermore, as Rao teaches thermal coatings, rather than catalytic effects, there is no suggestion that Rao can be combined with any other reference with respect to assertions of obviousness.

Accordingly, Applicant believes that Rao neither anticipates claim 2 as amended, nor is claim 2 obvious in view of Rao, and accordingly, claim 2 as amended is believed to be in allowable condition.

**D. Impropriety of Classification of Present Office Action as Final**

The Examiner may make an Office Action final where:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP 706.07(a). Notwithstanding that the present Office Action is the third Office Action in the present case, and as noted above, the Examiner raised for the first time a double patenting rejection. The Examiner also raised a new rejection of claim 1, asserting the claim to be anticipated by Rao, simply stating that "Rao teaches a coating having about 20% chromium." Claim 1, as originally submitted, also required the limitation that the coating have between "between greater than 15% and about 80% nickel." This limitation was not amended into claim 1 in response to the previous office action, and is not met by Rao.

The Examiner also raised a new rejection of claim 2 as being anticipated by Rao, asserting correctly that Rao discussed a coating having about 20% chromium. Claim 2 as previously presented included a lower limit of about 10% chromium. That limitation, however, was neither amended in nor discussed in the previous rejection, and accordingly the Examiner's contention that the new rejection was raised by some action of Applicant's is erroneous.

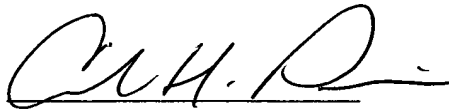
As the present rejections are not necessitated by any action or amendment of Applicant, Applicant believes that the Examiner incorrectly classified the Office Action as final,

they are improper, and accordingly requests withdrawal of the Final classification of the present Office Action.

**Conclusion**

Applicants respectfully request the issuance of a Notice Of Allowance for claims 1 and 2 at the earliest possible time. Applicants further respectfully request the courtesy of a telephone call should there be any outstanding issues related to the issuance of a Notice of Allowance in this matter.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C.H. Pierce', written over a horizontal line.

Carl H. Pierce  
Reg. No. 45,730  
Reed Smith LLP  
2500 One Liberty Place  
1650 Market Street  
Philadelphia, PA 19103-7301  
(215) 241-7970

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